

### **REMARKS**

This responds to the Office Action mailed on April 20, 2006. No claims are amended or cancelled. Claims 1-18 remain pending in this application.

#### **§103 Rejection of the Claims**

Claims 1-18 were rejected under 35 USC § 103(a) as being unpatentable over Webb (U.S. 6,542,371). The rejection states that “Webb discloses a high thermal conductivity heat transfer pad comprising all of the applicant’s claimed and disclosed limitation of the instant invention.” Applicant respectfully submits that not *all* elements are disclosed due to the nature of an obviousness rejection under 35 USC § 103(a). If *all* elements were disclosed, the rejection would be under 35 USC § 102. The rejection further states that “it would have been obvious to one of ordinary skill in the art at the time of invention for the high thermal conductivity heat transfer pad to have a distribution of carbon fibers within the viscous matrix material wherein orientation and location of carbon fibers relative to each other are moveable upon flow of the matrix material.” At least this limitation is not disclosed in Webb.

Applicant respectfully submits that under 35 USC § 103(a), Webb is not prior art with respect to the present application. Applicant notes that the Webb reference appears to be asserted under 35 USC §102(e). The present application was filed as a Continuation Application Under 37 C.F.R. 1.53(b) on September 26, 2003, however the present application is entitled to a priority date of the parent Application, filed on June 28, 2001. Webb was filed on November 2, 2000 and issued on April 1, 2003.

A reference asserted under 102(e) that was commonly owned with an application at the time the invention was made, cannot preclude patentability under 35 U.S.C. 103 when the application was filed on or after November 29, 1999. 35 U.S.C. 103(c); 1233 OG 55 (April 11, 2000). The present application was filed on September 26, 2003, which is after November 29, 1999. Webb and the present application were, at the time the invention was made, owned by, or subject to an obligation of assignment to, the same entity.

Thus, Webb is commonly owned with the present application and is not prior art. The Examiner has stated in the pending Office Action, that Webb does not show a distribution of carbon fibers within the viscous matrix material wherein orientation and location of carbon fibers relative to each other are moveable upon flow of the matrix material.” This deficiency in Webb, among others, leaves elements of Applicant’s claims 1-18 that are not shown or taught.

Because all elements are not found in any available cited art, the 35 USC §103(a) is not supported. Reconsideration and withdrawal are respectfully requested with respect to claims 1-18.

Conclusion

Applicant respectfully submits that the claims are in condition for allowance and notification to that effect is earnestly requested. The Examiner is invited to telephone Applicant's attorney ((612) 373-6944) to facilitate prosecution of this application.

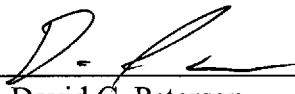
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Respectfully submitted,

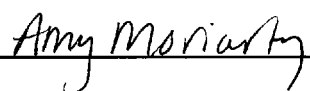
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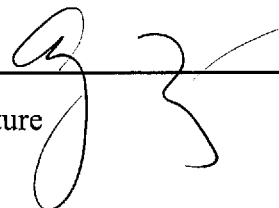
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Date 7-14-06

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CERTIFICATE UNDER 37 CFR 1.8: The undersigned hereby certifies that this correspondence is being filed using the USPTO's electronic filing system EFS-Web, and is addressed to: MS Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on this 14<sup>th</sup> day of June 2006.

  
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